# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| **Applicant:** | Handel et al. | | |
| **Serial No.:** | 09/195,852 | | |
| **Filing Date:** | 19 November 1998 | **Group Art Unit:** | 2177 |
| **Title:** | SHARING A CENTRALIZED PROFILE | **Examiner:** | S. Channavajjala |
| **Docket #:** | AND1P030 (60021/303001) | | |

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Washington, D.C. 20231

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
## BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

### APPELLANT'S APPEAL BRIEF

Dear Sir:

In response to the Office communication dated May 23, 2002, Appellant appeals the rejections of Examiner Channavajjala.

(1)   REAL PARTY IN INTEREST

The present application has been assigned to Accenture LLP, an Illinois corporation.

(2)   RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences related to the present case.

(3)   STATUS OF CLAIMS

Claims 1-2, 5-6, 8-12, 15-16, and 18-19 are pending and are herein appealed.

Claims 3-4, 7, 13-14, 17, and 20 have been cancelled in an Amendment and Response to Final Office Action, dated December 20, 2001.

All of the pending claims are rejected under 35 U.S.C. §103(a) as being unpatentable over Chrabaszcz, U.S. Patent No. 6,202,083 ("*Chrabaszcz*"), in view of Harris et al., U.S. Patent No. 6,331,972 ("*Harris*").

## (4)    STATUS OF AMENDMENTS

An After Final Amendment was filed October 23, 2002. An Advisory Action was received from the United States Patent and Trademark Office on November 5, 2002, in which Examiner Channavajjala indicated that the added limitations of the October 23, 2002 Amendment introduced new issues and did not place the application in better form for appeal. The amendments were not entered.

## (5)    SUMMARY OF INVENTION

The present invention generally provides for sharing user profile information, which is stored on a centralized database. *See* Specification, page 67, line 21-page 68, line 11; page 76, lines 18-20. Further, this user profile information may be accessed by third parties to provide the user with customized personal content and services. Appellant's claims capture the combination of two important improvements over existing systems: (1) a third party may access a subset of the user profile information, stored on a centralized database, and provide content to the user accordingly; and (2) the user may store content on the database and synchronize activities and content with the database from any Internet-enabled device.

In order to provide efficient functionality and services, the user profile information is maintained in a manner that allows for controlled access and use. User profile information is accessible by the user from any Internet enabled device, thus giving the user considerable flexibility. The user may also maintain and access various activities on the database (*e.g.* a calendar object or task list object), and the user may synchronize any Internet-enabled device with the database from any location. *See* Specification, page 76, line 23-page 77, line 2. Additionally, the user may grant third parties access to a subset of the user profile information so that the various activities can be enhanced or updated.

For the purposes of illustrating the present invention, Appellant will initially refer to independent claim 1 and the claim elements therein. Per claim elements (a), (b), and (c), the personal information, namely user profile information and Activities, are stored in the centralized database. *See* Specification, page 76, lines 18-20 ("this system provides one central storage place for a person's profile"); *see, also*, page 68, lines 22-25; page 70, lines 5-8. This aspect of the present invention, namely storing personal information in a centralized database, is also shown in Figure 17 (illustrating the profile database, element 1710) and Figure 10A (element 1060), and is further described in the Specification on page 70, lines 5-8: "The Customer Profile Database 1060 contains personal information about the customers, such as name, address, social security number and credit card information, personal preferences, behavioral information, history, and web site layout preferences." Additionally, this personal information may be entered and stored through a logistics

display shown in Figure 21. *See, also,* page 80, lines 11-22 (noting how profiles can be selected and updated).

Per claim elements (d) and (f), the user and a third party are provided access to the profile information on the centralized database. *See,* page 77, lines 4-18. This arrangement is illustrated in Figure 17, which shows a plurality of Internet enabled devices 1740, the profile database 1710, the third party merchant 1750, and the profile gateway server 1720 situated between the centralized database and the other elements.

Per claim element (e), the user provides permission to third parties to access specific personal information; *e.g.*, the user may grant certain merchants permission to access a public subset of the profile information. *See,* page 77, lines 15-18; *see, also,* page 77, lines 26-27 (describing how the third party "is then given access to a certain part of the consumer's profile that he has previously specified").

Per claim element (g), content from the third party is received, where the content is related to the activity. The third party merchants "will be able to access [the user profile] (given permission from the consumer who owns each profile), and will be able to offer customized, personalized services to consumers because of this." Page 77, lines 15-18. For instance, such customized, personalized services may include personalized content, *see* page 76, lines 22-23, managing billing information and response to hotel room preferences, *see* page 77, line 26—page 78, line 2, response to movie and dining preferences, *see* page 78, lines 2-3, and e-mail notices of specified events, *see* page 78, lines 3-4.

Per claim (h), content provided to the user by the third party is stored in the centralized database. For instance, if the third party is a hotel that provides checkin content for the user, transaction information regarding the checkin would be stored in the centralized database. *See* page 78, lines 5-7.

Per claim (i), activities (*e.g.*, calendar object, e-mail object, contact list object, task list object, and note object) can be synchronized between the centralized database and a remote, Internet-enabled device. *See* page 76, line 18—page 77, line 2. For instance, a user with an Internet-enabled PDA can remotely synchronize that device with the same centralized database that contains the user profile information, which can be accessed by third parties.

(6)     ISSUES

1)      Whether claims 1-2, 5-6, 8-12, 15-16, and 18-19 are unpatentable under 35 U.S.C. §103(a) over *Chrabaszcz* in view of *Harris*.

(7)     GROUPING OF CLAIMS

Claims 1-2, 5-6, 8-12, 15-16, and 18-19 are grouped together with respect to the rejection under 35 U.S.C. §103(a).

(8)     <u>ARGUMENT</u>

A.     *Background*

The new method for sharing a central profile that is provided by the present application represents an improved approach providing third party content based on user profile and activity information. This is a concept and method that is not taught or suggested by the prior art, and thus is patentable. The unique and novel aspects of this invention are further outlined below, but have all been presented to the Examiner through the prosecution of this application.

The present application was originally filed November 19, 1998. The first substantive Office Action addressing the merits of patentability was sent on February 18, 2000 (*see* paper number 7), at which time Examiner Khong rejected the pending claims 1-19 based on a combination of 35 U.S.C. § 112, paragraph 1, 35 U.S.C. § 102(e), and 35 U.S.C. § 103(a).

In Appellant's response to the February 18, 2000 Office Action, Appellant amended claims 1, 2, 10, 11, 12, submitted new claim 20, and set out detailed arguments directed towards the differences of the invention from the cited prior art references in response to the Examiner's rejections.

In his June 30, 2000 Office Action (*see* paper number 9), Examiner Channavajjala issued a final rejection, rejecting all claims under 35 U.S.C. § 102(e) based on a new grounds.

On October 30, 2000, Appellant filed a Continued Prosecution Application under 37 CFR § 1.53(d). On November 21, 2000, Examiner Channavajjala issued another final rejection (*see* paper 14).

In response to Examiner Channavajjala's rejections of November 21, 2000, Appellant amended claims 1, 2, 4, 5, 7-12, 14, 15, 17-19, submitted new claims 21-25, and cancelled claims 3, 6, 13, 16, and 19. Appellant further carefully distinguished the pending claims from the cited reference. This Amendment, submitted March 21, 2001, was not entered into the record. Appellant suspects the reason the Amendment was not entered is that the serial number on the Amendment was accidentally misprinted (09/195,8<u>9</u>2 instead of 09/195,8<u>5</u>2).

On May 21, 2001, Appellant filed a Notice of Appeal based on the Examiner's November 21, 2000, rejection of claims 1-20. Because the additional claims submitted in the March 21, 2001 Amendment were not entered, claims 21-25 were not pending at the time of the Notice of Appeal. Appellant did not file an Appeal Brief, but rather, Appellant opted to continue prosecution of this application before the Examiner.

On December 20, 2001, Appellant filed a Request for Continued Examination, under 37 CFR § 1.114, along with an Amendment. This Amendment amended claims 1, 2, 5, 6, 8-12, 15, 18, and 19, and deleted claims 3, 4, 7, 13, 14, 17, and 20. Appellant also distinguished the pending claims as amended from the cited reference in substantial detail.

In his January 9, 2002, non-final Office Action (*see* paper number 22), Examiner Channavajjala rejected all pending claims under 35 U.S.C. § 103(a) based on a new grounds. This rejection, based on U.S. Patent Nos. 6,202,083 and 6,331,972, still stands as of this appeal.

In response to the January 9, 2002, Office Action, Appellant thoroughly set forth factors that distinguish Appellant's invention from the cited references. Further, Appellant amended claim 16.

In his May 23, 2002 Office Action (*see* paper number 29), Examiner Channavajjala issued a final rejection for all pending claims, 1, 2, 5, 6, 8-12, 15, 16, 18, and 19, maintaining the rejections of the January 9, 2002, Office Action, Appellant's arguments notwithstanding.

In response to the Examiner's May 23, 2002 Office Action, Appellant asserted additional arguments in an effort to more clearly distinguish the claimed invention from the cited references in an Amendment submitted on July 23, 2002. On August 19, 2002, Examiner Channavajjala issued an Advisory Action (*see* paper number 31) wherein the Examiner indicated that the Appellant's July 23, 2002 Amendment failed to place the application in a condition for allowance because the claimed invention was rendered obvious over the prior art.

In an effort to resolve the apparent disagreement between the Examiner and the Appellant regarding the claimed invention and the cited references, Appellant requested an interview with the Examiner to discuss the relevant issues. On October 21, 2002, attorneys for Appellant, W. Glenn Edwards (Reg. No. 44,426) and Christopher Hilberg (Reg. No. 48,740), and Examiner Channavajjala conducted a telephone interview. *See* Interview Summary, dated October 23, 2002. During the course of this interview, the Examiner indicated several steps that could be taken by Appellant to further the prosecution of the application: (a) provide a concise statement of the present invention; (b) provide citations to the specification regarding the elements of the claimed invention; and (c) amend the claims to provide additional clarity to the relationship between the various claim limitations. *Id.*

On October 23, 2002, in response to the October 21, 2002 interview and the May 23, 2002 Office Action, Appellant filed an After Final Amendment and Response. In accordance with the Examiner's comments during the interview, Appellant (a) provided a concise statement of the present invention; (b) provided citations to the specification regarding the elements of the claimed invention; and (c) amended claims 1, 5, 6, 8-11, and 16 to provide additional clarity to the relationship between the various claim limitations. *See* Interview Summary, dated October 23, 2002 On November 1, 2002, Examiner Channavajjala issued another Advisory Action (*see* paper number 35) indicating that the claim amendments of the October 23, 2002 Amendment would not be entered because they raised new issues that would require further consideration or search, and they were not deemed to place the application in better form for appeal.

In response to Examiner Channavajjala's rejections of May 23, 2002 and Advisory Action of November 1, 2002, Appellant filed a Notice of Appeal on November 13, 2002. Each of the

Examiner's rejections will be addressed below and the applicable cases cited in those arguments will support the Appellant's position.

B.      *Rejection of Claims 1-2, 5-6, 8-12, 15-16, and 18-19 Under 35 U.S.C. § 103(a)*

The Examiner rejected claims 1-2, 5-6, 8-12, 15-16, and 18-19 under 35 U.S.C. §103(a) as being unpatentable over Chrabaszcz, U.S. Patent No. 6,202,083 ("*Chrabaszcz*"), in view of Harris et al., U.S. Patent No. 6,331,972 ("*Harris*"), asserting that it would have been obvious to one of ordinary skill in the art at the time of the Appellant's invention to combine certain features of the two references to obtain Appellant's invention. Specifically, the Examiner has asserted that, while *Chrabaszcz* fails to teach "third party access," "third party related to the activity," and "internet enabled device," *Harris* teaches these elements and it would have been obvious to combine these references. However, the references, either alone or in combination, fail to teach all of the claimed limitations of the present invention, and there is no suggestion or motivation to combine these references.

On this basis, Appellant respectfully traverses this ground of rejection.

(i)      A *Prima Facie* Case of Obviousness Requires the Prior Art References Teach All the Claim Limitations

Section 2143 of the MPEP provides in part, "To establish a *prima facie* case of obviousness ...the prior art reference ... must teach or suggest all the Claim limitations." (emphasis added). In the present case, *Chrabaszcz* and *Harris* fail to teach or suggest all of the limitations claimed.

Claim 1 of the present invention is a method for sharing a centralized profile, including the following elements:

(a)      obtaining user profile information;
(b)      obtaining at least one Activity from a user device, and wherein an Activity is a calendar, email, contact list, task list, or note;
(c)      storing the user profile information and the Activity in a centralized, Internet-accessible database;
(d)      providing a user access to the database from an Internet enabled device for allowing the user to alter the user profile information and to access the Activity;
(e)      receiving permission from the user to allow a third party to access a public subset of the user profile information;
(f)      providing the third party access to the public subset of the user profile information on the database;
(g)      receiving content from the third party related to the Activity;
(h)      storing the content from the third party in the database; and
(i)      synchronizing the database and an Internet enabled device so that the database and the Internet enabled device both contain the content and the Activities previously stored either on the Internet enabled device or on the database.

*Chrabaszcz* and *Harris* fail to teach or suggest all of these elements. Specifically, *Chrabaszcz* and *Harris* fail to teach or suggest at least the requirements for (a) obtaining an activity, where an activity is a calendar, email, contact list, task list, or note, (b) storing user profile information, an activity, and content from a third party in centralized, internet-accessible database, and (c) providing

a third party access to a public subset of the user profile information on the database. This lack of sufficient teaching is discussed in detail below.

(a)     *Obtaining an Activity, Where an Activity is a Calendar, Email, Contact List, Task List, or Note*

Independent claims 1, 10, and 11 provide for obtaining an Activity from a user device, "wherein an Activity is a calendar, email, contact list, task list, or note." In the Office Action dated May 23, 2002, the Examiner states that this claim element is taught by *Chrabaszcz*. Appellant respectfully disagrees.

*Chrabaszcz* discloses a method for updating wallpaper for a computer display based on a personal profile of a user. To support the proposition that *Chrabaszcz* teaches obtaining an activity from a user device as claimed in the present invention, the Examiner states in the May 23, 2002 Office Action that "Chrabaszez [sic] teaches for example news element 206, sports element 208 and community information element 210 is available in public space element 202 as detailed in fig 2." However, Appellant asserts that *Chrabaszcz* fails to disclose or suggest obtaining an Activity from a user device, wherein the Activity is <u>calendar information, e-mail messages, contact information, task information, or notes</u>, as claimed by Appellant. Contrary to statements in the outstanding Office Action, nowhere does *Chrabaszcz* disclose or suggest a calendar, email, contact list, task list, note.

(b)     *Storing User Profile Information, an Activity, and Content from a Third Party in Centralized, Internet-Accessible Database*

Independent claims 1, 10, and 11 provide for storing "user profile information and the Activity in a <u>centralized, Internet-accessible</u> database" and storing "the content [from the third party related to the Activity] in the database." (emphasis added). In the Office Action dated May 23, 2002, the Examiner states that storing the user profile and activity in a database is taught by *Chrabaszcz*. Appellant respectfully disagrees and asserts that this limitation is not taught by *Chrabaszcz*, *Harris*, or the combination thereof. Moreover, nowhere does the Examiner indicate where *Chrabaszcz* and *Harris* teach or suggest storing content received from a third party in the same database that stores the user profile and activity as claimed by Appellant.

As indicated, *Chrabaszcz* discloses a method for updating wallpaper for a computer display based on a personal profile of a user. Upon receiving a request for a wallpaper display, a fetching mechanism references a user database 306 to determine a personal profile for the user who generated the request. *See Chrabaszcz*, column 4, lines 39-42; Figure 3. The personal profile is used to select a wallpaper from a picture database 310. *Id.* at column 4, lines 48-51; Figure 3. The personal profile may contain information on what items and areas the user has referenced in the past and the user's security rights. *Id.* at column 4, lines 44-47.

Once the appropriate wallpaper is selected from the picture database 310, the fetching mechanism returns a file 314 to the <u>client</u> 110. *Id.* at column 4, lines 37-39; column 5, lines 8-13;

Figure 3, Figure 4. Importantly, the content received is not stored in the same database that stores the user profile information (user database 306) as claimed by Appellant in the present invention; rather, the content is received by client 110. The user database 306 and client 110 (or 114, 118; *See,* Figure 1) of *Chrabaszcz* are distinct entities.

*Harris* discloses a method for personalizing an electronic device through a personal area network. With respect to a user's personal information, personalization data 52 is stored in memory 42. *See Harris* at column 8, lines 8-14; Figure 2. The memory 42 is contained within a peer 20, as shown in Figure 1. *See* column 7, line 63-column 8, line 5. *Harris* also describes programming personalization data 52 into nearby appliances. *See* column 10, lines 7-11. However, nowhere does *Harris* describe receiving content from a third party, related to an activity, and storing that content in the same place as the personalization data 52, namely in the memory 42 or nearby appliances.

The discussion in *Harris* pertaining to receiving content from third parties is described in the context of a buyer/merchant/financial institute relationship, illustrated in Figures 30, 31 and 32. *Harris* describes financial institution 459 as a third party to supervise or guarantee a transaction between the buyer 452 and merchant 456. *See* column 24, lines 12-15; Figure 31. Alternatively, the transaction may be initiated and controlled through the buyer 452 with cooperation from the merchant 456 and financial institutions 458 and 460 (459). *See* column 24, lines 15-18; Figures 30, 32.

Describing this process in more detail, *Harris* teaches sending product and financial information from a personal transaction and storage device 407 to a merchant terminal 529. *See* column 26, lines 40-44. Then, a merchant terminal 529 transmits the financial information to a terminal belonging to a third party financial institution. *See* column 26, lines 44-50. Finally, the merchant, not the third party financial institution, sends a receipt and product codes to the user. *See* column 26, lines 55-59. Such "receipt and product codes" do not constitute content related to an activity, are not stored on the same database as the activity and user profile information, and are not received from the third party, as claimed in the present invention by Appellant.

Further, *Harris* indicates that personal transaction and storage device 407 may accept data being transmitted by a third party and saved in a database of the personal transaction and storage device 407. *See* column 21, lines 1-3. However, nowhere does *Harris* teach or suggest (a) that such data is related to an activity, or (b) that such data is saved in the same database as the activity and user profile information, as claimed in the present invention by Appellant.

In contrast, Appellant's invention as claimed provides for storing user profile information and an activity in a database and storing the content from a third party related to the activity in the same database. While this content may ultimately be synchronized onto an Internet enabled device from the database, the cited references plainly fail to teach or suggest storing user profile information, an activity, and third party content on a single database.

(c)     *Providing a Third Party Access to a Public Subset of the User Profile Information on the Database*

Independent claims 1, 10, and 11 require providing "the third party access to the public subset of the user profile information on the database" and receiving "content from the third party related to the Activity." In the Office Action dated May 23, 2002, the Examiner states that, while *Chrabaszcz* does not teach "third party access," this claim element is taught by *Harris*. Appellant respectfully disagrees. The Examiner asserts that *Chrabaszcz* teaches access to a public subset of user profile information on a database, but also states that *Chrabaszcz* fails to teach "third party access" and "third party related to the activity."

In Appellant's invention, the user has a user profile and at least one activity (such as personal calendar information, e-mail messages, contact information, task info, or notes) stored on a central database. The user can access this information anywhere via an Internet enabled device – such as with a Palm Pilot PDA or mobile telephone. Additionally, a third party may have access to a public subset of the user profile information on the database in accordance with the permissions received from the user.

Under Appellant's claimed invention, a user is able to setup a user profile so that a subset of the user profile information may be shared with third parties. Third parties are people, merchants, or other entities that offer products, services, and/or content other than the user. At any point, third parties with permission can access the user profile from the central database to discover the user's profile information. The third parties can then deliver to the database relevant content. Later, the user can access this newly stored content. For example, in the case where the Internet enabled device is a PDA, the user can synchronize the PDA so that both the PDA and the central database have a current version of the activity and the third party content.

In contrast, *Chrabaszcz* discloses a subdivided web site containing a public space and a private space. *See* Figure 2. Any user or person with access to the system can access information in the public space. The public space contains information such as news, sports, and community information. *See* column 3, lines 54-67. However, only a user with authorization (*e.g.*, a password) has access to the private space. The private space contains an individual user's personal information, such as membership lists and family reunion information. *See* column 4, lines 1-24.

Nowhere does *Chrabaszcz* teach or suggest allowing a third party to access user profile information. The "public space" of *Chrabaszcz* only includes non-personal information (*e.g.* news, sports, and community information). With respect to receiving permission from the user to allow a third party access to a public subset of user profile information, the Examiner points to *Chrabaszcz* at column 5, lines 37-43. Yet, the only permission *Chrabaszcz* discusses is a security list that specifies a user's right to add and delete users from a membership list and update wallpapers. *See* column 5, lines 37-43. These rights only grant the user permission to access and modify information already in the private space. *See* Figure 2. Nothing about these rights grants third parties permission to access the private space.

*Harris* also does not disclose a third party having access to user profile information on the user-accessible database, as claimed by Appellant. *Harris* discloses a system for personalizing an electronic device through a personal area network and describes a remote device access to the system. However, reading the entire disclosure of *Harris* shows that the reference teaches quite a different third party access than Appellant's invention. *Harris* discloses sending product and financial information from a personal transaction and storage device 407 to a merchant terminal, and then transmitting the financial information from the merchant terminal to a third party financial institution. *See* column 26, lines 40-50. Ultimately, a receipt and product codes are sent back to the user. *Id.* This discussion, which is cited by the Examiner in the May 23, 2002 Office Action, describes the transmission and flow of information.

Conspicuously absent from this description, however, is any teaching or suggestion of granting a third party access to a public subset of user profile information <u>on a user-accessible database</u>. Appellant maintains that there is a distinction between transmitting information from A to B, and granting B access to a subset of information in a database on A. Moreover, nowhere does *Harris* teach or suggest that content received from the third party is related to an activity, <u>where an activity is calendar information, e-mail messages, contact information, task information, or notes</u>, as claimed by Appellant.

Accordingly, for the above-indicated reasons Appellant asserts that *Chrabaszcz, Harris*, and the combination thereof fail to teach or suggest all the limitations of claims 1-2, 5-6, 8-12, 15-16, and 18-19.


(ii)    <u>A *Prima Facie* Case of Obviousness Requires a Suggestion or Motivation to Combine References</u>

Appellant respectfully submits that the objective tests for patentability set out in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), have not been met by the Examiner because a *prima facie* case of obviousness has not been established for the additional reason that there is no suggestion or motivation to combine the cited references. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). MPEP § 2142 provides, "To establish a *prima facie* case of obviousness...there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings."

Considering the scope of the cited prior art of record, the differences between the claimed invention and that of the prior art, and the level of skill in the art, the references <u>do no more than disclose some of the various elements that appear in the present Application</u>, none of which either alone or in combination meet all the limitations of claims 1-2, 5-6, 8-12, 15-16, and 18-19. Merely because various elements are shown in prior art is insufficient to support a rejection of the present claims under 35 U.S.C. § 103, and Appellant respectfully submits that this does not establish a *prima facie* case of obviousness.

MPEP § 2143.01 provides that there must be a basis in the art for combining or modifying references, and the "mere fact that references <u>can</u> be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." Establishing a *prima facie* case of obviousness requires more than "common knowledge" or "common sense." Rather, the Federal Circuit insists on a <u>specific rationale</u> for combining references and that a finding of obviousness be based on <u>objective evidence of record</u>. *In Re Lee*, 61 U.S.P.Q.2d 1430.

Such "specific rationale" and "objective evidence of record" are lacking from the present § 103 rejections. For instance, in the Office Action dated May 23, 2002, the Examiner notes that *Chrabaszcz* does not teach "third party access," "third party related to the activity," or "internet enabled device." The Examiner goes on to assert that "it would have been obvious [to] one of the ordinary skill in the art at the time of applicant's invention to incorporate the teaches of Harris et al." because both references are "directed to personalized collection of items." Even assuming *arguendo* that this observation is correct, it does not constitute "objective evidence of record" that the two references should be combined and that *Chrabaszcz* should be so modified. The Examiner does not describe why this would be a desirable improvement to *Chrabaszcz* or what problem of *Chrabaszcz* one would be attempting to solve with such a combination.

The Examiner states that one of ordinary skill in the art would be motivated to combine the references "because that would have allowed users of Chrabaszez's computer network to [improve] registration mechanism[s] for groups or members, more specifically third [parties] accessing personal profile for user information on user's interests, while preserving the user's security rights." Appellant respectfully disagrees with the Examiner's assertion and rationale.

*Chrabaszcz* describes a registration mechanism 304 for registering users for access to a group of wallpapers, which pertains to wallpaper access. The registration mechanism may specify a group with which to register the user, *see* column 5, lines 18-20, such as the canoe club or family reunion. On the other hand, *Harris* teaches approach 480, shown in Figure 31, whereby a buyer 452 and merchant 456 use a financial institution 459 as a third party to supervise or guarantee a transaction, *see* column 24, lines 12-15, which is purely a financial matter. Since *Chrabaszcz* does not indicate that the canoe club or family reunion conducts financial transactions, it is unclear what benefit they would receive from a third party financial institution or why one would be motivated to combine these references.

The source for the motivation to combine references must come from "the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." MPEP 2143.01. Nowhere does the Examiner describe the nature of the problem to be solved, the teachings of the prior art that lead to such motivation, or the knowledge of persons of ordinary skill in the art that would lead to such motivation.

35 U.S.C. §103 requires an analysis of the claimed invention as a whole; even where the claimed invention comprises individual components well known at the time of the invention, "[w]hat must be found obvious to defeat the patent is the claimed combination." *The Gillette Co. v. S.C. Johnson & Son Inc.*, 16 U.S.P.Q.2d 1923, 1927 (Fed. Cir. 1990). It is impermissible to simply engage in a hindsight reconstruction of the claimed invention, using the Applicant's structure as a template and selecting elements from references to fill in the gaps. The references themselves must provide some teaching whereby the Applicant's combination would have been obvious. *In re Gorman*, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991) (emphasis added).

Accordingly, for the above-indicated reasons, there is insufficient suggestion or motivation to combine *Harris* with *Chrabaszcz*. Because the cited references fail to suggest the combination of elements recited in the pending claims, whether viewed alone or in combination, Appellant respectfully submits that the pending claims are not obvious in view of the references.

    (iii)    Under the Applicable Law the Examiner Has Not Made a Sufficient 35 U.S.C. §103 Obviousness Rejection

Accordingly, for the above-indicated reasons *Chrabaszcz* and *Harris*, each alone or in combination, fail to disclose or suggest all the limitations of claims 1, 2, 5, 6, 8-12, 15, 16, 18 and 19. Moreover, there is a lack of motivation to combine the references. Nothing in either reference suggests the combination of the two references to teach remote third party access to a subset of a user's profile.

(9)    CONCLUSION

Pending claims 1-2, 5-6, 8-12, 15-16, and 18-19 remain rejected under 35 U.S.C. §103(a) as being unpatentable over *Chrabaszcz* in view of *Harris*. Appellant respectfully disagrees with the Examiner on this matter and request that the Board of Patent Appeals and Interferences reverse the Examiner's decision and allow the presently pending claims.

In summary, the present invention provides for sharing user profile information, which is stored on a centralized database. This user profile information may be accessed by third parties to provide the user with customized personal content and services. Appellant's claims capture the combination of two improvements over existing systems: (1) a third party may access a subset of the user profile information, stored on a centralized database, and provide content to the user accordingly; and (2) the user may store content on the database and synchronize activities and content with the database from any Internet-enabled device. This is a concept and method that is not taught or suggested by the prior art, and thus is patentable.

Should any additional fees be necessary, the Commissioner is hereby authorized to charge or credit any such fees or overpayment to Deposit Account No. 50-1901 (Reference #60021-303001).

Respectfully submitted,

By _Christopher R. Hilberg_
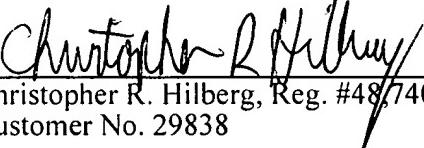
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Attachment:   Appendix (Claims Subject to Appeal)

## Claims Subject to Appeal

1.  A method for sharing a centralized profile, comprising:

    (a)  obtaining user profile information;

    (b)  obtaining at least one Activity from a user device, and wherein an Activity is a calendar, email, contact list, task list, or note;

    (c)  storing the user profile information and the Activity in a centralized, Internet-accessible database;

    (d)  providing a user access to the database from an Internet enabled device for allowing the user to alter the user profile information and to access the Activity;

    (e)  receiving permission from the user to allow a third party to access a public subset of the user profile information;

    (f)  providing the third party access to the public subset of the user profile information on the database;

    (g)  receiving content from the third party related to the Activity;

    (h)  storing the content from the third party in the database; and

    (i)  synchronizing the database and an Internet enabled device so that the database and the Internet enabled device both contain the content and the Activities previously stored either on the Internet enabled device or on the database.

2.  The method for sharing a centralized profile as recited in claim 1, wherein the third party is a merchant utilizing the user profile information for offering a personalized service to the user.

5.  The method for sharing a centralized profile as recited in claim 1, further comprising updating a third-party application based on a change in the user profile information.

6.  The method for sharing a centralized profile as recited in claim 1, further comprising storing rules in the database indicative of information usage in the user profile information.

8.  The method for sharing a centralized profile as recited in claim 1, wherein the profile information is grouped in an optimal manner for a third-party target application.

9.  The method for sharing a centralized profile as recited in claim 1, wherein the Internet enabled device is a gas meter, electricity meter, telephone, television, computer, smart card, pocket organizer, personal digital assistant, vehicle, kitchen appliances, lights, security system or home monitor.

10. A system that supports a shared centralized profile, comprising;

    (a)    a processor;

    (b)    a memory that stores information under the control of the processor;

    (c)    a code segment that obtains user profile information;

    (d)    a code segment that obtains at least one Activity from a user device, and wherein an Activity is a calendar, email, contact list, task list, or note;

    (e)    a code segment that stores the user profile information and the Activity in a centralized, Internet accessible database;

    (f)    a code segment that provides a user access to the database from an Internet enabled device for allowing the user to alter the user profile information and to access the Activity;

    (g)    a code segment that receives permission from the user to allow a third party to access a public subset of the user profile information;

    (h)    a code segment that provides the third party access to the public subset of the user profile information on the database;

    (i)    a code segment that receives content from the third party related to the Activity;

    (j)    a code segment that stores the content from the third party in the database; and

    (k)    a code segment for synchronizing the database and an Internet enabled device so that the database and the Internet enabled device both contain the content and the Activities previously stored either on the Internet enabled device or on the database.

11. A computer program embodied on a computer-readable medium that is executed by a computer to create a shared centralized profile, comprising:

    (a)    a code segment that obtains user profile information;

    (b)    a code segment that obtains at least one Activity from a user device, wherein an Activity is a calendar, email, contact list, task list, or note;

    (c)    a code segment that stores the user profile information and the Activity in a centralized, Internet accessible database;

    (d)    a code segment that provides a user access to the database from an Internet enabled device for allowing the user to alter the user profile information and to access the Activity;

    (e)    a code segment that receives permission from the user to allow a third party to access a public subset of the user profile information;

    (f)    a code segment that provides the third party access to the public subset of the user profile information on the database;

    (g)    a code segment that receives content from the third party related to the Activity;

    (h)    a code segment that stores the content from the third party in the database; and

(i)      a code segment that synchronizes the database and an Internet enabled device so that the database and the Internet enabled device both contain the content and the Activities previously stored either on the Internet enabled device or on the database.

12.      The computer program embodied on a computer-readable medium as recited in claim 11, wherein the third party is a merchant utilizing the user profile information for offering a personalized service to the user.

15.      The computer program embodied on a computer-readable medium as recited in claim 11, further comprising a code segment that updates a third-party application based on a change in the user profile information.

16.      A computer program embodied on a computer-readable medium as recited in claim 11, further comprising a code segment that stores rules indicative of information usage in the user profile information.

18.      The computer program embodied on a computer-readable medium as recited in claim 11, wherein the profile information is grouped in an optimal manner for a third-party target application.

19.      The computer program embodied on a computer-readable medium as recited in claim 11, wherein the Internet enabled device is a gas meter, electricity meter, telephone, television, computer, smart card, pocket organizer, personal digital assistant, vehicle, kitchen appliances, lights, security system and home monitor.